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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,569	07/22/2003	Akiko Miyano	Q76408	6558
65565 7590 09/24/2007 SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213				
EXAMINER				
DESAL, ANISH P				
ART UNIT		PAPER NUMBER		
1771				
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09/24/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/623,569

Applicant(s)

MIYANO ET AL.

Examiner

Anish Desai

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 07/26/07 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/26/07 has been entered.
2. Claims 1 and 9-16 are pending.
3. A new 35 USC Section 112-first paragraph rejection is made.
4. All of the previously made art rejections are maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim language of claims 14 and 15 is grammatically ambiguous. Specifically, claims 14 and 15 recite "substrate comprises a supporting substrate and colored layers". Claims 14 and 15 depend from claim 1, which already discloses colored layers. Therefore, a question is raised whether the "colored layers" of claims 14 and 15 are in addition to the colored layers of independent claim 1 or the "colored layers" of claims 14 and 15 refers to colored layers of claim

1. For the purpose of the examination, colored layers of claims 14 and 15 are interpreted as the same colored layers as required by claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 9-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vesley et al. (US 4,950,537), substantially as set forth in 04/26/07 Office Action.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vesley et al. (US 4,950,537) in view of Kameyama et al. (US 6,166,799) substantially as set forth in 04/26/07 Office Action.

Response to Arguments

8. Applicant's arguments filed 07/26/07 have been fully considered but they are not persuasive.

Applicant argues that the double sided adhesive tape of the present invention does not aim at "forming the esthetically pleasing pressure-sensitive adhesive tape", but aims at reconciling light-reflecting properties and light-shutting properties. According to Applicant, the arrangement of the colored layers as set forth in the claims are needed to practice the aforementioned light-reflecting properties and light-shutting properties. The Examiner does not find the argument persuasive because it is not commensurate in scope with the claim language.

Claims do not require the adhesive tape having light-reflecting properties and light-shutting properties.

Applicant argues that it is not usually considered by one of ordinary skill in the art to form a layer of color other than white and black between the white layer and the black layer because the esthetic pleasure of the pressure-sensitive adhesive tape is deteriorated when both surface layers of the pressure sensitive adhesive tape is deteriorated when both surface layers are desired to be white and black, respectively. Applicant's argument are not found persuasive in determination of patentability because they are based on Applicant's personal opinion and presented without any factual evidence on the record. Additionally, it is not clear as to what is meant by "esthetic pleasure of the pressure-sensitive adhesive tape is deteriorated when both surface layers are desired to be white and black, respectively".

Applicant argues that the Examiner has not provided any basis or support for his position that one in the possession of Vesley's invention can easily choose colored layers and the arrangement of the colored layers as required by the claims because choosing desired color and arranging them in an order to form an esthetically pleasing PSA tape involves routine skill in the art. It is noted that Vesley's reference discloses a double-sided PSA tape having one or more layers of pressure-sensitive adhesive (see Section 3 page 2 of 04/26/07 Office Action). Further, Vesley discloses that at least one layer of the pressure-sensitive adhesive having a pigment-coated microbubbles dispersed therein (see Section 3 page 2 of 04/26/07 Office Action and abstract). Additionally, Vesley teaches that the adhesive tape of his invention can have any desired color (see Section 3 page 2 of 04/26/07 Office Action and column 2 lines 53-54). The difference between Vesley's invention and the presently claimed invention is specific color

layers as claimed by Applicant and their arrangement as presently claimed. It is noted that choosing a specific color or their arrangement is not critical to practicing Vesley's invention, therefore absent any unexpected results, a skilled artisan can choose any color layers and arrange them in any order to make esthetically pleasing tape.

Applicant argues that although Vesley discloses that more than one layer may comprise pigment-coated microbubbles, Vesley does not specifically disclose any specific embodiments or Examples containing more than one colored PSA layer. The Examiner does not appreciate the moment applicant urges this point. The Examiner respectfully reminds Applicant that one cannot ignore the broad teaching of Vesley which discloses a double-sided PSA tape having one or more layers of pressure-sensitive adhesive (see Section 3 page 2 of 04/26/07 Office Action). There is no requirement that every embodiment of the prior art be exemplified before it can render unpatentable a claimed invention. Further, Vesley discloses that at least one layer of the pressure-sensitive adhesive having a pigment-coated microbubbles dispersed therein (see Section 3 page 2 of 04/26/07 Office Action and abstract). Additionally, Vesley teaches that the adhesive tape of his invention can have any desired color (see Section 3 page 2 of 04/26/07 Office Action and column 2 lines 53-54).

It is noted from the specification that having colored layers of specific colors and arranging them in a specific order may be useful in the liquid crystal display (LCD) technology, but claims (i.e. independent claim) do not recite such use and limitation from the specification cannot be read into the claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2004/0028895A1 to Yamakami discloses an adhesive tape combining light reflectivity and light shielding characteristics. Figure 6 of Yamakami discloses a double-sided adhesive tape having adhesive layer 4/black ink layer 8/thin metal layer 7/light reflective film of white color 1/adhesive layer 4. However, the date of filing and date of publication of Yamakami reference is after the effective filing date of Applicant's application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./
APD

/Terrel Morris/
Terrel Morris
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